

Form P16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 04 2004

In Re Application of: : Attorney Docket: 37026-88081
Tadashi NARIU, et al. : Group Art Unit: 2815
Application Serial No: 10/618,374 : Examiner: Eugene Lee
Filed: 07/11/2003 :
For: IMAGE SENSOR :

PETITION FOR EXTENSION OF TIME

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply to the Office Action/Restriction Requirement dated 7 June 2004 in the above identified application, due 7 July 2004. Please extend the period for filing a reply for three months, for an extended due date of 7 October 2004.

The fee for extension of time (large entity; less the small entity reduction if applicable) of \$980.00 is:

☐ Submitted herewith.

☒ to be charged to Deposit Account 07-1985.

Please charge any deficiency in fees and credit any excess in fees to Deposit Account 07-1985.

Showing of Due Care and Inability to Respond Within Time Set for Response

Nature of Delay: Petition for extension of the time for response.

Showing of Need and Special Circumstances: The extension was needed because of the extreme complexity of restriction issues in this large application of many claims arising from the numerous groups of claims proposed by examiner in a restriction requirement, and length of the necessary disclosure of the application and its many claims, and because of the necessary coordination of the matter to obtain instructions regarding response from applicant representative of Japan, and communication between said representative and Applicants and their company.

NARIU et al.
SN 10618,374
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Adjustment Date: 09/19/2005 SDIRETH1
10/26/2004 TBELL1 00000001 071985 10618374
01 FC:1253 980.00 CR

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Showing of Due Care: The applicants, applicant's representative in Japan, and U.S. representatives of applicant all acted with due diligence and rapidity, using electronic communication. All communications between the undersigned and applicant were made diligently, by the most efficient means, with due dispatch and with due care. Attention was duly given to docket matters in sequence. Despite due care, there was inability of Applicants to advise the undersigned in the specifics of response within the set time for response for the reasons set forth above. In view of the foregoing, additional time was required in order to respond to the Official Action.

Request for Disposition. In view of these circumstances, the Patent and Trademark Office should not subtract from the ultimate term of the patent the term of the petition for extension submitted herewith. This request is made in accordance with Patent Term Guarantee Act of 1999 and 37 CFR 1.701-705.

Respectfully submitted,

Date:

4 October 2004

Peter S. Gilster, Reg. No. 25,337
Greensfelder, Hemker & Gale, P.C.
Intellectual Property Group
10 South Broadway, Suite 2000
St. Louis, MO 63102-1774
Direct telephone: 314-345-4741
General telephone: 314-241-9090
Facsimile: 314-345-4704
Attorneys for Applicants
Customer No. 22,807

psg:kmb

NARIU et al.
SN 10/618,374
732615

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

NARUI et al.

: Attorney Docket: 37026-88081

Serial No.: 10/618,374

: Group Art Unit: 2815

Filed: July 11, 2003

: Examiner: Eugene Lee

TITLE AS FILED: **IMAGE SENSOR, METHOD OF FABRICATING THE SAME, AND
EXPOSURE APPARATUS, MEASURING DEVICE, ALIGNMENT
DEVICE, AND ABERRATION MEASURING DEVICE USING THE
IMAGE SENSOR**

TITLE AS AMENDED: **IMAGE SENSOR**

**REQUEST FOR REFUND OF EXTENSION FEES
AND FOR WAIVER OF THE RULES**

U.S. Patent and Trademark Office
Attention: Refunds Branch
20011 Crystal Drive
Crystal Park One, Suite 807
Arlington, VA 22202

Applicants request refund of extension fees in the amount of \$980.00 paid on applicants' behalf in this application for response to the Official Action of June 7, 2004 and for waiver of the rules, to the extent that may be required to permit such refund, for the reasons set forth below:

1. Statement of Facts.

Applicants were provided with an Official Action dated June 7, 2004, that was a restriction requirement. Applicants, being the assignees to a large foreign entity, were compelled to provide a detailed response. Because of the need to research the facts in this complicated application of many claims, to prepare a detailed response, and to work through applicants' representative in Japan, and with correspondence to and from the undersigned and applicants' representative in Japan, a response (normally a one-month period for response) could not be submitted within the set one-month period because of the complexity as aforesaid until October 4, 2004, and such required applicants to submit Petition for Extension of Time to respond, with extension fees totaling \$980.00.

Applicants also sought to interview the examiner because of what now appeared to be an inappropriate situation.

Upon attempted telephone inquiry of the examiner regarding obtaining an interview schedule, a telephone message was left for the undersigned, from which it appeared that examiner finally did agree

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SN 10/618,374
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that the restriction requirement should never have been given, as the examiner had apparently now realized that he had not given attention to a preliminary amendment submitted by applicants. Thus, the examiner by such telephone message led the undersigned to believe that the restriction requirement would at long last accordingly be withdrawn and that the examiner would then proceed with examination, the claims to be examined being 1-9, 12-15, and 21. The message further advised that there did not appear to be a need for interview with the examiner as there had been achieved what was necessary to proceed with examination.

An Official Action dated January 11, 2005, was then received on the merits of the claims, to which applicants responded on April 11, 2005.

The examiner acquiesced in the position of the applicants, as effectively evident from the Official Action dated January 11, 2005, that applicants' preliminary amendment dated October 15, 2003, had properly placed the claims in issue before the examiner and had, in retrospect, rendered unnecessary that examiner impose a restriction requirement.

2. Applicable Rules. 37 CFR §1.183 permits suspension of the patent rules and request for suspension of the rules.

3. Action Requested and Argument In Support Thereof. As a result of this situation, applicants have been inadvertently and without applicants' fault placed in a situation of having paid for an extension fee. The Commissioner for Patents should take official notice of the fact that the Patent and Trademark Office does not consider the merits of an argument in determining whether an extension fee is required, but considers only the calendar date of actions and date of response. Thus, in order to bring facts concerning the claims before the examiner to allow examiner to consider the merits of the claims, applicants were, in effect, compelled to pay the extension fee, as imposed by regulation, and were not in any position to petition the Commissioner at the time of responding to the Official Action, in view of the need to research the facts in this complicated application of many claims, to prepare a detailed response, and to work through applicants' representative in Japan, and with correspondence to and from the undersigned and Applicant's representative in Japan. Only by responding to the Official Action and bringing facts to the attention of the examiner could applicants present the issues regarding the claims in issue, as well as show that a restriction requirement was not required.

Thus, the need for extension was not within the control of applicants or their representatives but instead compelled by the regulations, which applicants followed in order to bring the application and its issues again before the examiner.

Because, in retrospect, the applicants had a need to research the facts in this complicated application of many claims, to prepare a detailed response, and to work through applicants' representative in Japan, and with correspondence to and from the undersigned and Applicants' representative in Japan,

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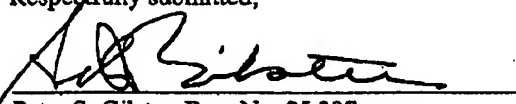
and as a result of the development of the facts and response, and examiner's reconsideration thereof, it appeared that applicants should never have had to pay an extension fee, then applicants should be entitled to refund of the extension fee paid in the amount of \$980.00, in order to remedy a manifest injustice to applicants' company in having paid the fee.

Because the regulation regarding the time period for requesting a refund is not a requirement of the statutes but rather a matter of the rules, and because justice so requires to avoid a clear injustice to applicants' assignee, it is hereby respectfully requested that the Office suspend or waive the three month restriction for requesting a refund and that applicant be granted a refund in the amount of \$980.00 and that the rules be waived to the extent necessary.

It is not believed that any petition fees are due in connection with this submission, but should a petition fee be deemed by the Office to be required, please charge such fee or any deficiency to Deposit Account 07-1985.

Respectfully submitted,

28 April 2005
Date


Peter S. Gilster, Reg. No. 25,337
Attorney for Applicant
Greensfelder, Hemker & Gale, PC
10 S. Broadway, Suite 2000
St. Louis, Missouri 63102
314-241-9090 Telephone
314-345-4704 Facsimile
Customer Number 22807

Please acknowledge receipt of the following:

Pat/Ser. No.: 10/614,374Docket No.: 37026-88081Applicant: NARVE, et al.Title: IMAGE SENSOR

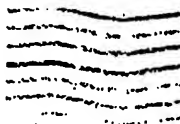
<input type="checkbox"/> Application containing ___ pages	<input type="checkbox"/> Issue Fee
<input type="checkbox"/> Declaration and Power of Attorney	<input type="checkbox"/> Maintenance Fee (___ year)
<input type="checkbox"/> Assignment	<input type="checkbox"/> Change of Attorney Address
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Petition to Revoke
<input type="checkbox"/> PTO Form SB/08 w/copies of references	<input type="checkbox"/> Notice of Filing CPA Application
<input type="checkbox"/> Drawings ___ Sheets (Formal/Informal)	<input type="checkbox"/> PCT Request for Filing Int. Appln.
<input type="checkbox"/> Response to Missing Parts	<input type="checkbox"/> Chapter II Demand (___ pages)
<input type="checkbox"/> Amendment (___ pages)	<input type="checkbox"/> Response to Correct Defects
<input type="checkbox"/> Request for Extension of Time	<input type="checkbox"/> Amend Under Art. 19/Art. 34
<input type="checkbox"/> Notice of Appeal	<input type="checkbox"/> Check (\$___)

X Other: Postal Card, Request for Refund of Extension Fees
and For Refund of the Rules Transmitter, Certificate of Mailing

Express Mail Label No.: _____

Date: Apr. 28, 2005Attorney: P. Gilster / K. Benett

637148



Carlsbad Caverns National Park, NM

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INTELLECTUAL PROPERTY GROUP
GREENSFELDER, HEMKER & GALE, PC
2000 EQUITABLE BLDG.
10 S. BROADWAY
ST. LOUIS, MO 63102-1747



Form P26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of: :
: :
NARUI et al. : Attorney Docket: 37026-88081
: :
Serial No.: 10/618,374 : Group Art Unit: 2815
: :
Filed: July 11, 2003 : Examiner: Eugene Lee

TITLE AS FILED: IMAGE SENSOR, METHOD OF FABRICATING THE SAME, AND
EXPOSURE APPARATUS, MEASURING DEVICE, ALIGNMENT
DEVICE, AND ABERRATION MEASURING DEVICE USING THE
IMAGE SENSOR

TITLE AS AMENDED: IMAGE SENSOR

CERTIFICATION OF FACSIMILE TRANSMISSION

TO: Facsimile #571-273-6500
U.S. Patent and Trademark Office
Attention: Refund Department
Alexandria, VA

FROM: Peter S. Gilster, Reg. No. 25,337
Greensfelder, Hemker & Gale, P.C.
Intellectual Property Group
CUSTOMER NUMBER 22807

Number of Pages Transmitted (including this page): 7

I hereby certify that these papers are being RESUBMITTED BY FACSIMILE TRANSMISSION to the Patent and Trademark Office on the date shown below. The documents listed below were first submitted on April 28, 2005 and deposited with the United States Postal Service in an envelope addressed to U.S. Patent and Trademark Office, Attention: Refunds Branch, 20011 Crystal Drive, Crystal Park One, Suite 807, Arlington, VA 22202 with first class postage.

- 1) Request For Refund Of Extension Fees And For Waiver Of The Rules;
- 2) Transmittal of Request For Refund Of Extension Fees And For Waiver Of The Rules;
- 3) Postal Card (true photocopy).

Please charge any additional costs, or credit any overpayment or refund, to our Deposit Account No. 07-1985.

Respectfully submitted,

July 26, 2005
Date

Kathi Berndt
Name: Kathi Berndt
Greensfelder, Hemker & Gale, PC
10 S. Broadway, Suite 2000
St. Louis, Missouri 63102
314-241-9090 Telephone
314-345-4704 Facsimile

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Form P25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

NARUI et al.

Attorney Docket: 37026-88081

Serial No.: 10/618,374

Group Art Unit: 2815

Filed: July 11, 2003

Examiner: Eugene Lee

TITLE AS FILED:

IMAGE SENSOR, METHOD OF FABRICATING THE SAME, AND
EXPOSURE APPARATUS, MEASURING DEVICE, ALIGNMENT
DEVICE, AND ABERRATION MEASURING DEVICE USING THE
IMAGE SENSOR

TITLE AS AMENDED: IMAGE SENSOR

CERTIFICATION OF MAILING
UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.10

U.S. Patent and Trademark Office
Attention: Refunds Branch
20011 Crystal Drive
Crystal Park One, Suite 807
Arlington, VA 22202

Sir:

I hereby certify that, on the date shown below, this correspondence and enclosures identified below are being deposited with the United States Postal Service in an envelope addressed to U.S. Patent and Trademark Office, Attention: Refunds Branch, 20011 Crystal Drive, Crystal Park One, Suite 807, Arlington, VA 22202.

37 C.F.R. Section 1.8(a)

37 C.F.R. Section 1.10*

☒ with sufficient postage as first class
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☐ as "Express Mail Post Office to Addressee"
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Enclosures:

- 1) Request For Refund Of Extension Fees And For Waiver Of The Rules;
- 2) Transmittal of Request For Refund Of Extension Fees And For Waiver Of The Rules;
- 3) Postal Card.

Please charge any deficiency in fees and please credit any excess in fees in connection with this submission to Deposit Account 07-1985.

Respectfully submitted,

28 April 2005
Date

Kathi Berndt
Name: Kathi Berndt
Greensfelder, Hemker & Gale, PC
10 S. Broadway, Suite 2000
St. Louis, Missouri 63102
314-241-9090 Telephone
314-345-4704 Facsimile

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Form P25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

NARUI et al.

: Attorney Docket: 37026-88081

Serial No.: 10/618,374

: Group Art Unit: 2815

Filed: July 11, 2003

: Examiner: Eugene Lee

TITLE AS FILED: IMAGE SENSOR, METHOD OF FABRICATING THE SAME, AND
EXPOSURE APPARATUS, MEASURING DEVICE, ALIGNMENT
DEVICE, AND ABERRATION MEASURING DEVICE USING THE
IMAGE SENSOR

TITLE AS AMENDED: IMAGE SENSOR

TRANSMITTAL OF REQUEST FOR REFUND OF EXTENSION FEES
AND FOR WAIVER OF THE RULES

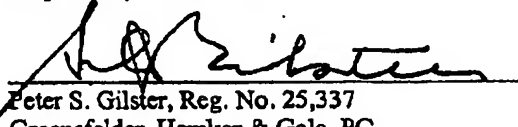
U.S. Patent and Trademark Office
Attention: Refunds Branch
20011 Crystal Drive
Crystal Park One, Suite 807
Arlington, VA 22202

Sir:

Submitted Herewith Is The Request For Refund Of Extension Fees And For Waiver Of The
Rules.

Respectfully submitted,

28 April 2005
Date


Peter S. Gilster, Reg. No. 25,337
Greensfelder, Hemker & Gale, PC
10 S. Broadway, Suite 2000
St. Louis, Missouri 63102
314-241-9090 Telephone
314-345-4704 Facsimile
CUSTOMER NUMBER: 22807

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